

### REMARKS

Claims 1-15 were examined and reported in the Office Action. Claims 1-15 are rejected. Claim 2 is canceled. Claims 1, 3 -10 and 15 are amended. Claims 1 and 3-15 remain.

Applicants request reconsideration of the application in view of the following remarks.

#### **I. 35 U.S.C. §103**

A. It is asserted in the Office Action that claims 1-4, 6-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 6,240,444 issued to Fin et al. ("Fin") in view of no other prior art. Applicant respectfully disagrees.

According to MPEP §2142 "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." (In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Further, according to MPEP §2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." "*All words in a claim must be considered* in judging the patentability of that claim against the prior art." (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), emphasis added.)

Applicant's amended claim 1 contains the limitations of "[a] cooperative computer based system including a plurality of clients and a server for editing a web document, the cooperative computer based system comprising: a first user interface module in each of the plurality of the clients for generating editing instructions by

receiving data from a user; a first document manager module in each of the plurality of the clients for converting the editing instruction into a message and transmitting the message, and modifying a copy of the web document and informing a modification of the copy to the first user interface module; a second document manager module in the server for modifying contents of the web document by receiving the message from the first document manager module; and a second user interface module in the server for transmitting and informing a modification of the web document to the first document manager."

Applicant's amended claim 10 contains the limitations of "[a] method for cooperative editing of the web document in a cooperative computer based system including a server and a plurality of clients, the method comprising the steps of: a) at a client, generating editing instructions, converting editing instructions to a message related to editing and transmitting the message related to editing to the server; b) at the server, if the web document can be modified, modifying contents of a copied web document stored in the server conforming to the message related to editing; and transmitting the message related to editing to the plurality of the clients; and c) modifying contents of the copied web document stored in each of the plurality of the clients conforming to the message related to editing transmitted from the server."

Applicant's amended claim 15 contains the limitations of "[a] computer-readable record media storing instructions for performing a method for editing a web document cooperatively in a cooperative computer based system including a server and a plurality of clients, the method comprising the steps of: a) at a client among the plurality of the clients, generating editing instructions, converting editing instructions to a message related to editing and transmitting the message related to editing to the server; b) at the server, determining if the web document can be modified, based on the message related to editing; modifying contents of a copied web document stored in the server conforming to the message related to editing; and transmitting the message related to editing to the plurality of the clients; and c) modifying contents of the copied web document stored in each of the plurality of the clients conforming to the message related to editing transmitted from the server."

Fin discloses a system and a method for allowing one or more Internet browsers to simultaneously control one or more other Internet browsers and for allowing two or more Internet users to simultaneously collaborate a HTML page. Fin includes steps for processing, such as sending user input keystrokes from the keyboard; creating message events; and displaying the same key strokes on the receiving user's screen. Fin, however, does not teach, disclose or suggest editing key strokes displayed by the other user. Although Fin discloses window resizing and scrolling, Fin does not introduce a method for editing contents of the web document stored in the server, which is shared by a plurality of users.

Distinguishable from Fin, in order to edit the web document Applicant's claimed invention includes a system and a method for editing a web document by generating editing instructions, transmitting the editing instructions to the server on the client's side, editing a web page according to the editing instructions, and transmitting the message related to editing to a plurality of the clients on the server side, and modifying contents of the copied web document on the client's side, where the modifying is done at the clients side.

Fin does not disclose, teach or suggest all the limitations contained in Applicant's amended claims 1, 10 and 15, as listed above. Therefore, there would not be any motivation to combine Fin with teachings known in the art as the resulting combination would still not result in Applicant's claimed invention. Thus, Applicant's amended claims 1, 10 and 15 are not obvious over Fin since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from claims 1 and 10, namely claims 2-9, and 11-14, respectively, would also not be obvious over Fin for the same reason.

Accordingly, withdrawal of the 35 U.S.C. §103(a) rejection for claims 1 -4, and 6-15 is respectfully requested.

**B.** It is asserted in the Office Action that claim 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over Fin as applied to claim 2 above and, in view U. S. Patent No. 6,446,093 issued to Tabuchi et al. ("Tabuchi"). Applicant respectfully disagrees.

Applicant's amended claim 5 now depends from amended claim 1. Applicant has addressed claim 1 in view of Fin above in section I(A).

Tabuchi discloses a document sharing management method for a document server and a plurality of clients that are connected to the document server via a network. Each of the clients transmits to the document server an original transaction with information indicative of at least one client that uses a document. The document server receives the original transaction, processes the original transaction as a global document generation transaction to produce a document object. The global transaction is transmitted to the client as a local transaction. The client receives the local transaction and performs the local transaction to produce a virtual document object corresponding to the document object.

Distinguishable from Fin, Tabuchi, or a resulting combination of the two, in order to edit a web document Applicant's claimed invention includes a system and a method for editing the web document by generating editing instructions, transmitting the editing instructions to the server on the client's side, editing a web page according to the editing instructions, and transmitting the message related to editing to a plurality of the clients on the server side, and modifying contents of the copied web document on the client's side, where the modifying is done at the clients side.

Neither Fin, Tabuchi, or the combination of the two disclose, teach or suggest all the limitations contained in Applicant's amended claim 1, as listed above. Therefore, there would not be any motivation to combine Fin with Tabuchi, as the resulting combination would still not result in Applicant's claimed invention. Thus, Applicant's amended claim 1 is not obvious over Fin in view of Tabuchi since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claim that directly depends from claim 1, namely claims 5, would also not be obvious over Fin in view of Tabuchi for the same reason.

Accordingly, withdrawal of the 35 U.S.C. §103(a) rejection for claim 5 is respectfully requested.

**CONCLUSION**

In view of the foregoing, it is believed that all claims now pending, namely 1 and 3 -15, patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,

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By: \_\_\_\_\_

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I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on June 7, 2004.

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Jean Svoboda